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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHELL S. SIMPSON

Appeal 2009-004345
Application 10/052,617
Technology Center 2600

Decided: May 17, 2010

Before ROBERT E. NAPPI, CARL W. WHITEHEAD Jr., and BRADLEY W. BAUMEISTER, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the rejection of claims 1 through 19 and 21 through 35. Appeal Brief 2.

We affirm-in-part and enter a new rejection.

INVENTION

The invention is directed to method of generating notification that a print to mail document has been printed. See pages 8 and 9 of Appellant's Specification. Claim 1 is reproduced below:

1. A method for print-to-mail notification, comprising:
determining that a print-to-mail format document has been generated by printing, folding, and sealing the document as a mailing;
identifying attributes of the print-to-mail format document; and
generating notification information that identifies that the print-to-mail format document has been generated, thereby indicating that the document has been printed, folded, and sealed as a mailing.

REFERENCES

Gleason	US 5,091,777	Feb. 25, 1992
Tammi	US 5,726,897	Mar. 10, 1998
Pollard	US 5,745,590	Apr. 28, 1889
Stewart	US 6,714,964 B1	Mar. 30, 2004

REJECTIONS AT ISSUE

The Examiner has rejected claims 1 through 7, 12 through 15, 18, 19, 21, 26, and 27 under 35 U.S.C. § 103(a) as being unpatentable over Tammi in view of Gleason. Answer 4-7.¹

The Examiner has rejected claims 8 through 10, 16, and 22 through 25 under 35 U.S.C. § 103(a) as being anticipated by over Tammi in view of Gleason and Stewart. Answer 7-10.

The Examiner has rejected claims 11 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Tammi in view of Gleason and Pollard. Answer 10.

The Examiner has rejected claims 28, 29, 32, 33, 34, and 35 under 35 U.S.C. § 103(a) as being unpatentable over Tammi in view of Gleason, Pollard and Appellant's Admitted Prior art. Answer 11.

¹ Throughout this decision we refer to the Examiner's Answer dated Feb. 5, 2008. We note that this Answer contains a new ground of rejection which complies with MPEP 1207.02(A)(6)(d). Contrary to Appellant's arguments the Answer does not run afoul of 37 C.F.R. 41.43(a)(2), as the Answer was submitted in response to an Order Dated Dec. 20, 2007, not in response to a Reply Brief filed by Appellant. Regardless, any issues raised by Appellant' arguments directed to the propriety of new rejection in this Answer are moot as we enter a new ground of rejection.

ISSUES

Rejection under 35 U.S.C. § 103(a) as being unpatentable over Tammi in view of Gleason.

Appellant argues on pages 7 through 18 of the Appeal Brief² that the Examiner’s rejection under 35 U.S.C. § 103(a) based upon Tammi in view of Gleason is in error. Appellant asserts on pages 9 and 10 of the Appeal Brief that Tammi does not teach that signals provided to the system control by the post processing system (which folds, inserts, and seals) are provided after the post processing is complete. As such Appellant concludes that Tammi does not teach “determining that a print to mail format document has been generated by printing, folding, and sealing the document as a mailing” as recited in claim 1 or as similarly recited in independent claims 12, 18, or 28. Appeal Brief 10 through 13, 17, and 18.

Appellant also argues that Tammi does not teach that a print-to-mail format document is generated. Appellant argues that Tammi teaches generating a printed mail statement that is placed into an envelope. Appellant argues that this is different than a print-to-mail format document that is generated by folding, printing, and sealing and thus, does not require an envelope. Appeal Brief 13-16.

Thus, Appellant’s arguments directed to the rejections of independent claims 1, 12, 18, and 21 present us with the following issues:

² Throughout the opinion, we refer to the Appeal Brief filed February 27, 2007; Reply Brief filed April 4, 2008; and Appellant’s Response Filed July 24, 2008.

a) Does the combination of Tammi in view of Gleason teach generating notification information that identifies that a print-to-mail document has been generated?

b) Does the combination of Tammi in view of Gleason teach generating print-to-mail documents as claimed?

FINDINGS OF FACT

1. Appellant admits that at the time of the invention it was known to have appliances that print statements on heavy weight media. These appliances would fold the media, and seal it to form a mailing (thus, it was known to create a print-to-mail document). Specification 1.
2. Tammi teaches a mail assembly system which makes use of non-printed data to control documents in the system. Abstract.
3. Tammi's system includes a printing system item 20 and a post processing system 70. *See* Figure 1.
4. Tammi's post processing system includes items such folders, inserters, sealing machines, and postage metering machines. The post processing system can have more or fewer machines as required for the mailing being created. Tammi, col. 9, ll. 55-60, col. 21, ll. 46-48.
5. Tammi's post processing system also includes sensors 105a-c which monitors the position of documents through the post processing system: e.g. sensors monitor that a document has finished having one post-processing process performed and is moving to the next. Tammi, col. 21, 43-60, col. 24, ll. 9-20, col. 26 ll. 42-53.

6. These sensors are also used to verify that processing is performed, and the system controller sends an acknowledgement signal when the outputs of these sensors indicate that a mailing has successfully traversed the post processing system. Tammi, col. 22, ll. 10-20, col. 24 ll. 9-47, and col. 26 ll. 55-67.

ANALYSIS

Rejection under 35 U.S.C. § 103(a) as being unpatentable over Tammi in view of Gleason.

At the outset we note that we will not sustain the Examiner's rejection of claims 1 through 7, 12 through 15, 18, 19, 21, 26, and 27 under 35 U.S.C. § 103(a) as being unpatentable over Tammi in view of Gleason, as we find that the combination of Tammi and Gleason does not teach print-to-mail documents as claimed. However, as discussed *infra*, we find that the combination of Appellant's admitted prior art, Tammi, and Gleason suggest that the claimed method for creating print-to-mail documents is obvious. Accordingly, we enter a new rejection of these claims based upon Tammi, Gleason, and Appellant's Admitted prior art. In so doing, we adopt the Examiner's findings concerning the limitations not argued by the Appellant of claims 1 through 7, 12 through 15, 18, 19, 21, 26, and 27, and we address the issues raised by Appellant's arguments as they apply to the new rejection.

First Issue.

Appellant's arguments have not persuaded us that the combination of Tammi in view of Gleason and Appellant's admitted prior art teach generating notification which identifies that a print to mail document has

been generated. Claim 1 recites generating notification information that identifies that the print-to-mail document has been printed, folded, and sealed. Independent claims 1, 12, and 18 recite limitations directed to similar notifications. As discussed *infra* we find that the combination of the references teach generating a print-to-mail format document. The Examiner in rejecting the claims finds that Tammi's teaching of the post processing system verifying receipt of a document meets the claimed generating a notification. Answer 5 and 15 through 17. We concur with and adopt the Examiner's findings as we find that they are supported by ample evidence. *See* Facts 3-6. Tammi teaches that the post processing system performs operations such as folding, and sealing of a document that has been printed. Facts 3 and 5. Tammi teaches that the post processing system includes various sensors (items 105a-c), which confirm that the mailing has successfully traveled through the elements of the post processing system. Fact 5. Tammi teaches a verification system that works with the sensors and provides an acknowledgement signal if all of the sensors indicate proper completion of the post processing operations. Fact 6. Appellant's argument on pages 11 and 12 of the Brief, that the sensors verify prior to post processing, is not persuasive as we find that Tammi teaches that the sensors monitor progress at various stages in the post processing and that the output of all the sensors used to provide verification that the post processing is properly performed. Fact 6. Thus, Appellant's arguments have not persuaded us of error in finding that the combination of Tammi, Gleason, and Appellant's admitted prior art teach generating notification information as recited in the independent claims.

Second issue

As identified above Appellant's arguments have persuaded us that the Examiner erred in finding that the combination of Tammi in view of Gleason teaches generating a print to mail documents as claimed. However, we find that Appellant's Admitted prior art makes up for this missing teaching.

In rejecting independent claims 1, 12, and 18, the Examiner states that the claims do not define a print-to-mail document as a document which can be mailed without an envelope. Answer 18. While we concur with the Examiner's claim interpretation, we note that claim 1 identifies that the print-to-mail document is one that is sealed. The Examiner has not shown that Tammi teaches sealing the document, but rather sealing the envelope in which the document is placed. Accordingly, we do not find that Tammi teaches print-to-mail documents as claimed.

Nonetheless, Appellant admitted that it was known to generate print-to mail-documents which are sealed and as such do not need envelopes for mailing. Fact 1. Tammi identifies that the post processing section could be modified to accommodate different types of mailings. Fact 4. Thus, we consider the use of Tammi's system of monitoring post processing on print-to-mail documents to be obvious as it is nothing more than using a known system for monitoring the printing and processing of mailings for a known type of mailing. Accordingly, we now reject claims 1 through 7, 12 through 15, 18, 19, 21, 26, and 27 under 35 U.S.C. § 103(a) as being unpatentable over Tammi, Gleason, and Appellants' Admitted prior art.

Rejections of dependent claims 8-11, 16, 17, 24, 35, 30 and 31.

The Examiner's rejections of these dependent claims relies upon the same rationale discussed above with respect to independent claims 1, 12, and 18. We will not sustain the Examiner's rejection of these claims, for the reasons discussed *supra*. However, as noted above though, we find that the Appellant's admitted prior art teaches the limitation missing from these rejections. Accordingly, we now reject the claims by adopting the Examiner's reasoning and modified the rejection to additionally rely upon the Appellant's Admitted prior art. Accordingly, we enter the following new rejections:

- a) Claims 8 through 10, 16, and 22 through 25 under 35 U.S.C. § 103(a) as being anticipated by over Tammi in view of Gleason, Appellant's Admitted prior art, and Stewart; and
- b) Claims 11 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Tammi in view of Gleason Appellant's Admitted prior art and Pollard.

Appellants arguments directed to the Examiner's rejection of these claims present us with the same issues discussed *supra* with respect to independent claims 1, 12, and 18. Similarly, these arguments have not persuaded us that the new rejection is in error.

Rejection of claim 28, 29, 32, 33, 34, and 35.

Appellant's arguments directed to the rejection of these claims present us with the same issues discussed *supra* with respect to claim 1, 12, and 18. Additionally, Appellant's argue that "no admissions by Applicant remedy the deficiencies of the Tammi, Gleason and Pollard references." Appeal

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Brief 19. As discussed above we find that the Appellant's Admitted prior art does remedy the deficiencies noted in the rejection of claims 1, 12, and 18. Accordingly, we sustain the Examiner's rejection of claims 28, 29, 32, 33, 34, and 35.

SUMMARY

We will not sustain the Examiner's rejection of claims 1 through 19, 21 through 27, 30, and 31 under 35 U.S.C. § 103(a). However, we sustain the Examiner's rejection of claims 28, 29, 32, 33, 34, and 35 under 35 U.S.C. § 103(a) as being unpatentable over Tammi in view of Gleason, Pollard, and Appellant's Admitted Prior art. We enter a new rejection against claims 1 through 19 and 21 through 27, 30, and 31 under 35 U.S.C. § 103(a).

ORDER

The decision of the Examiner to reject claims 1 through 19 and 21 through 35 is affirmed-in-part.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). This section provides that “[a] new ground of rejection... shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event

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the proceeding will be remanded to the examiner. . . .

(2) Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

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AFFIRMED-IN-PART
37 C.F.R. § 41.50(b)

ELD

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